

REMARKS:

The Office Action dated July 25, 2003, has been carefully considered. In response thereto, the present application has been amended in a manner that is believed to place it into condition for allowance. Accordingly, reconsideration and withdrawal of the outstanding final Office Action and issuance of a Notice of Allowance are respectfully requested.

In the present Office Action, the Examiner has accepted the new drawing submitted (received by the PTO) May 14, 2003, objected to the specification, and objected to claims 22, 24, 25 and 26. In addition, the Examiner has rejected claims 15-28 under 35 U.S.C. § 112, first and second paragraphs and rejected claims 15-27 under 35 U.S.C. § 103(a). As discussed below, Applicant has addressed each of those objections and rejections.

Drawing:

Applicant acknowledges that the corrected and substitute drawing submitted to the PTO on May 14, 2003, has been accepted by the Examiner. A final drawing, without correction marks, is enclosed herewith for the record.

Claims Numbering:

Claims 15-29 are pending in the application. As noted in Applicant's previous paper, the claims were incorrectly numbered in Applicant's November 30, 2001, Preliminary Amendment. However, a complete listing of the pending claims was not provided with that paper showing the proper number sequence. This paper contains a complete listing and status of the claims pending in the application.

Specification Objections:

Applicant submits that the updated specification, adding the reference number "12" for the target or rebound board (as shown in corrected FIG. 1 of the application), adequately responds to and overcomes the Examiner's objection of the specification. Withdrawal of the objection is respectfully requested.

Claim Objections:

Claims 22, 24 and 25 have been objected to under 35 U.S.C. § 112, first paragraph, because “one or both guideways” should read “at least one guideway.” Claim 26 has been objected to under 35 U.S.C. § 112, first paragraph, because “of the or each guideway” should read “of the at least one guideway.”

Applicant has amended the claims according to the Examiner’s suggestions. Applicant wishes to point out that those amendments do not narrow the scope of the claimed invention. Thus, Applicant is entitled to the full scope of protection afforded the claimed invention without limitation (subject to any relevant prior art).

Claim Rejection - 35 U.S.C. § 112, first paragraph:

As noted previously, the Examiner has rejected claims 15-28 under 35 U.S.C. § 112, first paragraph. That is, the Examiner asserts that the claims recite subject matter that was not described in the specification so as to enable one of ordinary skill in the art to make and/or use the invention. The basis for the Examiner’s rejection is essentially a repeat of his previous rejection contained in the December 12, 2002, Office Action. The Examiner questions whether the written description adequately conveys information to answer the following exemplary questions: (1) What is the minimum spacing and maximum spacing of the guideways?; (2) What is the buffering and/or deflector means?; (3) How is the tension mechanism used?; (4) How is the inclination varied?

As Applicant understands the Examiner’s comments, the rejection is based on the portion of 35 U.S.C. § 112, first paragraph, dealing with enablement. For the reasons described below (and in Applicant’s previous submitted papers), Applicant respectfully submits that the Examiner has not established a prima facie case of lack of enablement under 35 U.S.C. § 112, first paragraph.

“The enablement requirement is satisfied when one skilled in the art, after reading the specification, could practice the claimed invention without undue experimentation.” AK Steel Corp. v. Sollac, 68 U.S.P.Q.2d 1280, 1287 (Fed. Cir. 2003) (citing cases). “The determination of what constitutes undue experimentation in a given case requires the application of a standard of reasonableness, having due regard for the nature of the invention and the state of the art.” In re Wands, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir. 1988) (citing

Ansul Co. v. Uniroyal, Inc., 169 U.S.P.Q. 759, 762-63 (2d Cir. 1971), cert. denied, 172 U.S.P.Q. 257 (1972)). “The test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, *or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed.*” Id. (emphasis added).

1. What is the minimum spacing and maximum spacing of the guideways?

As disclosed in the specification, the guideways diverge, the minimum separation distance between the guideways is less than the length of the inelastic reciprocating line, and the maximum separation distance is greater than the line length. Thus, the minimum and maximum spacings between the guideways are dictated by the length of the line and (vice versa) by the fact that the guideways diverge. Accordingly, one skilled in the art, after reading the specification, could practice the claimed invention without undue experimentation because the specification provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed. While it may require some adjustments of the guideways to find an appropriate divergence and line lengths (and hence the spacing of the guideways), that “experimentation” is not “undue.” For that reason, there is no need to recite a minimum or maximum spacing for the guideways to enable the claimed invention.

2. What is the buffering and/or deflector means?

Under 35 U.S.C. §112, first paragraph, the statute requires “only that the inventor enable one of skill in the art to make and use the full scope of the *claimed invention.*” CFMT Inc. v. Yieldup International Corp., 68 U.S.P.Q.2d 1940, 1944 (Fed. Cir. 2003) (emphasis added). Thus, it is the claimed invention that the enablement requirement applies to. In this case, there are no claims directed to a buffering and/or deflector means. Thus, the Examiner’s rejection is improper to the extent it is directed to the enablement requirement.

However, to clarify this issue, the specification has been amended to state that it is the backboard or target 12, as shown in FIG. 1 in the alternate position between the tee-off mat 10 and the supports 2, that is the structure corresponding to the deflector (the “buffer” and “means” terms being deleted from the specification). New claim 29 is directed to the

backboard or target being used as a deflector. Because FIG. 1 clearly shows a backboard or target, which can act as a deflector, the specification is enabling with respect to the invention claimed in claim 29.

3. How is the tension mechanism used?

Claims 26 and 27 are directed to the tensioning means. The tensioning means simply comprises, for each guideway, a reel around which a guideway is wound. A greater or lesser winding imposes variations in the tension in the guideways. This is clearly described in the specification on page 4 of the application. A person skilled in the art would understand from the specification that there are many ways in which the tension of each guideway can be varied, one of which comprises the reel referred to in the specification. Applicant submits that no, or at the very least only a very little, experimentation would be required to tighten the guideways, especially where the specification provides a roadmap for using a simple reeling mechanism. Accordingly, the specification is enabling with respect to the invention claimed in claims 26 and 27.

4. How is the inclination varied?

Again, from the perspective of one of ordinary skill in the art, there can be no doubt that little, if any, experimentation would be required to determine how to use the invention disclosed in the specification, specifically how it can be manipulated to incline the guideways as shown in FIG. 1. The inclination can simply be varied by increasing or reducing the distance between the anchorages and the stable support, or by varying the height of the support. Applicant respectfully submits that the Examiner has not established that the specification lacks enablement.

For the above reasons, Applicant respectfully submits that the Examiner has not established a prima facie case of lack of enablement under 35 U.S.C. §112, first paragraph, and respectfully requests that the rejection of the claims on that basis be withdrawn.

Claim Rejection - 35 U.S.C. § 112, second paragraph:

The Examiner has rejected claim 15 (and dependent claims 16-28) as being indefinite because the minimum and maximum spacing of the guideways is not recited. For the reasons described below, Applicant respectfully submits that the Examiner has not established that claim 15 is indefinite under 35 U.S.C. §112, second paragraph.

As the Federal Circuit has stated many times, “[I]f the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 [second paragraph] demands no more.” Miles Lab., Inc. v. Shandon, Inc., 27 U.S.P.Q.2d 1123, 1140 (Fed. Cir. 1993); Honeywell Int’l, Inc. v. ITC, 68 U.S.P.Q.2d 1023, 1028 (Fed. Cir. 2003) (citing cases) (“The definiteness requirement [] focuses on whether the claims, as interpreted in view of the written description, adequately perform their function of notifying the public of the scope of the patentee’s right to exclude.”).

Applicant regards as his invention the combination of elements disclosed in the specification including diverging guideways and a substantially inelastic line that is longer than the minimum separation of the guideways and shorter than the maximum separation of the guideways. In fact, as any person of ordinary skill would conclude, the recitation of elements in claim 15 can be summed up as follows: for a line having length “x,” the distance between the guideways at their closest or minimum separation is less than “x” and the distance between the guideways at their maximum separation is greater than “x.” The actual minimum and maximum distances are not relevant. Thus, the claim reads on any length “x,” and thus any minimum and maximum separation distances, limited only by the relevant prior art. Thus, the claim is definite because it reasonably apprises those skilled in the art of the scope of the invention. Obviously, one of ordinary skill will understand that the invention will not work in the manner disclosed in the specification if the “substantially inelastic reciprocating line” is one mile long, or, conversely, one millimeter long. But those, or other limits, do not have to be recited in the claim to make the claim definite and satisfy § 112, second paragraph. Therefore, Applicant respectfully requests that the rejections of claim 15 be withdrawn.

With regard to claim 28, Applicant has amended the claim to recite the physical relationship between the backboard or target and the rest of the apparatus. As disclosed in the specification, “[t]he target may be placed at any position remote from [] the lower end of

the guideways.” Thus, it could be positioned behind the device so that it does not actually physically touch the device as shown in FIG. 1. Accordingly, the new language added to claim 28, “wherein the backboard or target is positioned in the path of a trajectory of the ball,” provides the relationship between the apparatus and the backboard or target and is adequately supported by the written description of the invention. Withdrawal of the rejection of claim 28 is respectfully requested.

With regard to the antecedent basis problems: (1) claim 15 has been amended to replace “the” with “a,” where applicable, to address the Examiner’s rejection; (2) claims 16 and 18 have been amended to recite “first” and “second” ends of the guideways, respectively, rather than “one end” and the “other end”; (3) claims 22 and 25 have been amended to replace the typographical error “reciprocating means” with the correct “reciprocating line” term; and (4) claim 28 has been amended to omit the reference to “the user.” Applicant wishes to point out that those amendments do not narrow the scope of the claimed inventions recited in those claims. Thus, Applicant is entitled to the full scope of protection afforded the claimed inventions without limitation (subject to any relevant prior art).

Claim Rejection - 35 U.S.C. § 103(a)

The Examiner has rejected claims 15-27 under 35 U.S.C. § 103(a), as being unpatentable over Great Britain Patent No. GB 201,645 to *Gilbey-Thompson* in view of U.S. Patent No. 3,630,521 to *Lingbeek*. For the reasons noted below, Applicant respectfully traverses the Examiner’s rejection on the basis of those two references and submits that the Examiner has failed to establish a prima facie case of obviousness.

Gilbey-Thompson discloses a golf practicing device which comprises two slightly diverging wires or cords secured between ground anchors and a pair of upstanding stakes. *Lingbeek* discloses an apparatus for practicing baseball swings in which a ball is attached to an elastic line stretched between spaced apart horizontal guideways supported by spaced apart vertical supports. Applicant submits that those references do not render the invention recited in claims 15-27 of the present application unpatentable because there is no teaching or motivation to combine them to come up with the present invention.

Although there are some similarities, the main differences between the device disclosed in *Gilbey-Thompson* and that of the present invention is the manner in which the

ball is secured to the reciprocating line. As recited in claim 15, the invention includes "a ball connected to and generally coaxial with the reciprocating line." In *Gilbey-Thompson* the ball is attached to the reciprocating line by a cord which is in turn secured to the reciprocating line through a ring. The function of the reciprocating cord is to communicate to the player whether the ball was struck squarely, pulled or sliced. The intention is that the ball will remain at some position between the lines remote from the striking position, the distance of the ball from a center line between the diverging lines providing an indication as to the manner in which the ball was struck.

That system is contrary to the present application where the ball is caused by the reaction between the inelastic ball carrying line and the diverging guideways to produce a whip-like reaction which causes the reciprocating line with the ball attached to return to the original striking position. It is the line connecting the ball to the reciprocating line of *Gilbey-Thompson* which prevents the return of the ball to the striking position. In the present application, it is the location of the ball generally coaxial with the reciprocating line which enables the ball to be returned in the manner described in the specification. Thus, claim 15 is clearly distinguished over the teaching of *Gilbey-Thompson*.

There are obvious distinctions between the reciprocating means described in *Lingbeek* and that of the invention claimed in the subject application, which was discussed at length in Applicant's previous paper. The main distinction between the present claimed invention and the disclosure in *Lingbeek* is that in *Lingbeek* the reciprocating means is positioned between two spaced apart horizontal guideways that are parallel (i.e., they do not diverge) and that the reciprocating line of *Lingbeek* is elastic. In *Lingbeek*, the elastic line converts the kinetic energy of the ball after it is struck by a bat into potential energy which is then used to propel the ball back to the player. Thus, claim 15 is clearly distinguished over the teaching of *Lingbeek*.

As understood from the Examiner's reason for the obviousness rejection, *Gilbey-Thompson* teaches every element of the claims except it does not disclose wires being elastic, but that *Lingbeek* discloses low friction lines that enhance travel of the lines connected to the guideways and one of ordinary skill in the art would have been motivated to use low friction lines taught in *Lingbeek* in place of the non-elastic lines in *Gilbey-Thompson* to facilitate the smooth movement of the ball of the present invention after it has been struck.

Applicant submits that the Examiner's reasoning does not establish a prima facie case of obviousness. The main differences between the present claimed invention and the teachings of *Gilbey-Thompson* and *Lingbeek* are not addressed by the combination of the two patents. Modifying the non-elastic wires in *Gilbey-Thompson* with the so-called low friction guideways taught in *Lingbeek* would not result in the a device that operates like the present invention that has two diverging guideways, a substantially inelastic reciprocating line between the two guideways, and a ball connected to and generally coaxial with the substantially inelastic reciprocating line.

And even if the two references did teach that combination of elements, which Applicant submits they do not, the Examiner has not stated any motivation to combine those two references to come up with the *claimed invention* recited in claim 15 that operates in the way disclosed in the specification. The motivation cited by the Examiner – to facilitate the smooth movement of the ball after it has been struck – is not the purpose of the diverging guideways and substantially inelastic reciprocating line. Therefore, one of ordinary skill in the art would not have been motivated to use *Lingbeek* to modify the teaching in *Gibley-Thompson* to come up with the present invention. Withdrawal of the obviousness rejection is respectfully requested.